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Dated: February 12, 2004

Signature:

(Opelle R. Cockings)

Docket No.: DAMADIAN 3.0-079
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Bonanni et al.

Application No.: 09/988,941

Group Art Unit: 2859

Filed: November 21, 2001

Examiner: Shrivastav, Brij. B.

For: FERROMAGNETIC FRAME WITH
LAMINATED CARBON STEEL

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This communication is in response to the Official Action mailed January 13, 2004, setting forth a restriction requirement in the above-identified application. Applicants provisionally elect, with traverse, Group I, claims 1-27.

In the Official Action, the Examiner identified the following two groups of inventions as being distinct:

I. Claims 1-27, drawn to a ferromagnetic structure for a magnetic resonance imaging magnet, classified in class 324, subclass 318.

II. Claims 28-43, drawn to a method of constructing or fabricating a ferromagnetic structure, classified in class 335, subclass 299.

In requiring a restriction between the inventions of Group I and Group II, the Examiner asserts that although related, the inventions of Groups I and II are distinct. In particular, the Examiner asserts that Groups I and II are related as a process of making a product and a product made by the process. (M.P.E.P. § 806.05(f), pg. 800-45.) The Examiner then

concludes that the inventions are distinct because "in the instant case use of electromagnet(s) in place of ferromagnetic structure to create a homogeneous magnetic field [sic]." Applicants respectfully submit that the Examiner has not made the case that these inventions are distinct. Indeed, the Examiner has not given any reason to support a showing "(1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process." That is, the Examiner's statement that "in the instant case use of electromagnet(s) in place of ferromagnetic structure to create a homogeneous magnetic field" does not meet either of the requirements, i.e., requirement (1) or (2) in the previous sentence, necessary to support a showing of distinctiveness under M.P.E.P. § 806.05(f). Thus, applicants respectfully traverse the Examiner's statement that "restriction for examination purposes as indicated is proper."

The Examiner also asserts that the restriction is proper because "the search required for Group I is not required for Group II." In this regard, the criteria for restriction between patentably distinct inventions require that there "be a serious burden on the Examiner." (M.P.E.P. § 803.01, pg. 800-4.) Inasmuch as in the Notice of Allowance mailed June 4, 2003 (Paper No. 5) the Examiner allowed all the claims presently pending in the application, i.e., claims 1-43, the Examiner clearly already searched all of the pending claims. Therefore, applicants respectfully submit that the subject matter to which the claims of Groups I and II are drawn does not place a serious burden on the Examiner.

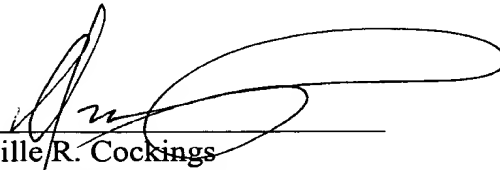
In view of the foregoing, applicants respectfully submit that the Examiner has improperly required that the inventions as claimed be restricted between Groups I and II. Accordingly, applicants urge that the Examiner withdraw the restriction requirement. Further in this regard, applicants respectfully request that the Examiner examine all the claims included in Groups I and II, in particular claims 1-43, presently pending in the application. Applicants also respectfully submit that these claims are in condition for allowance. As such, early and favorable action is earnestly requested.

Applicants also reserve the right to file divisional applications to any claim presently pending and which is not examined in the present application.

In the event any fee is due in connection with the present response, the Examiner is authorized to charge Applicant's Deposit Account No. 12-1095 therefor.

Dated: February 12, 2004

Respectfully submitted,

By 

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